

REMARKS

The application has been carefully reviewed in light of the Office action, and amended as necessary to better conform with the formal requirements of U.S. practice and to more clearly and particularly describe the subject matter which Applicant regards as the invention.

Prior to this Amendment "B", claims 1-19 were pending in the present application. In this Amendment "B", claims 1-19 have been canceled and new claims 20-32 have been added. Reconsideration of the present application in its current format is hereby respectfully requested.

In the Office action, the Examiner maintained his species election requirement and made it final. Although claims 1-19 have been canceled, Applicant assumes this requirement applies to new claims 20-32. Applicant submits that new claims 20-30 read on the elected species IV of Fig. 6b. Applicant, however, still traverses the species election requirement for the reasons set forth in Applicant's first response. Applicant would like to further add that MPEP §1850 states (with emphasis added) "when the Office considers International applications as an International Searching Authority, as an International Preliminary Examining Authority, ***and during the national stage as a Designated or Elected Office under 35 U.S.C. 371***, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories ***without regard to the practice in national applications filed under 35 U.S.C. 111***." MPEP §1850 further states (with emphasis added) that "Unity of invention has to be considered in the first place only in relation to the independent claims in an international application ***and not the dependent claims.***"

In the Office action, the Examiner objected to the drawings presumably

because the same reference numbers are used for different embodiments of the joining element shown in Fig. 2. In response, Applicant has amended paragraphs [0035] and [0036] of the specification and corrected Fig.2 to change the reference numbers among the various embodiments. Replacement Sheets and Annotated Marked-Up Drawings sheets showing the changes are enclosed herewith.

The Examiner has objected to claims 1, 11, 12 and 19 and has rejected claims 1-10 under 35 U.S.C §112, second paragraph, as being indefinite. Since claims 1-19 have been canceled, these rejections are moot. Applicant submits that new claims 20-32 meet the requirements of 35 U.S.C §112, second paragraph.

The Examiner has rejected claims 1-3, 7, 9 and 10 under 35 U.S.C §112, first paragraph for failing to comply with the written description requirement. Although these claims have been canceled, Applicant wishes to address this rejection because the Examiner may make a similar rejection with regard to new claims 20-32. The Examiner asserts that there is no support in the specification for the recitation in claim 1 that the mechanical excitation is generated once the surface has been penetrated. Applicant respectfully submits that this assertion is incorrect.

Paragraph [0033] on pages 11 and 12 of the specification fully supports this recitation. Paragraph [0033] reads in part:

"After the point 5 of the dowel 1 has reached a certain depth of penetration (Figure 1b) and/or the force F has reached a certain magnitude, the dowel 1 by means of the ultrasound generator in active connection with the holder 2 is put into oscillation, here in the direction of the z-axis."

Accordingly, Applicant submits that claims 1-19 met the written description requirement of 35 U.S.C §112, first paragraph, as do new claims 20-32.

In the Office action, the Examiner rejected claims 1-3, 7, 9-13 and 19 under 35 U.S.C. §102(a) as being anticipated by publication WO98/42,988, and rejected

claims 11 and 15 under 35 U.S.C. §102(a) as being anticipated by Japanese Patent No. JP-5-245,941. Although these claims have been canceled, Applicant wishes to address this rejection because the Examiner may make similar rejections with regard to new claims 20-32.

Both the publication WO98/42,988 and the Japanese Patent No. JP-5-245,941 disclose forming a bore in a body first and *then* inserting a joining element in the bore. Thus, neither the publication WO98/42,988, nor the Japanese Patent No. JP-5-245,941 show or suggest (with emphasis added): the step of "*applying a force to the second end portion of the joining element such that the first end portion of the joining element breaks through the surface of the first body*", as is recited in new independent claim 20; or a combination of a "body" and a "joining element", wherein the combination is formed by "*applying a force to the second end portion of the joining element such that the first end portion of the joining element breaks through the surface of the first body and penetrates into the porous material, thereby compressing the porous material disposed around the first end portion*", as is recited in new independent claim 27. In addition, the Japanese Patent No. JP-5-245,941 discloses the body as being composed of a thermoplastic resin. Thus, the Japanese Patent No. JP-5-245,941 fails to show or suggest (with emphasis added): a "body comprising a **porous** material" as is recited in new independent claims 20 and 27. For at least these reasons, Applicant submits new independent claims 20 and 27 and, thus, new dependent claims 21-26 and 28-32 are patentable over the publication WO98/42,988 and the Japanese Patent No. JP-5-245,941.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance,

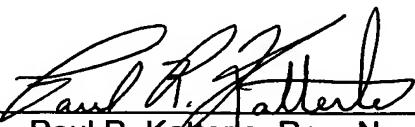
the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. FRR-12806.

Respectfully submitted,

RANKIN, HILL, PORTER & CLARK LLP

By:



Paul R. Katterle, Reg. No. 36,563

March 2, 2004

4080 Erie Street
Willoughby, Ohio 44094-7836
(216) 566-9700
Customer No. 40854